

DETAILED ACTION

Status of Claims

1. This action is in reply to application 10/758234 filed on 01/15/2004. Claims 1-63 are currently pending and have been examined.

Election/Restrictions

2. Applicant's election with traverse of group II in the reply filed on 04/27/2009 is acknowledged. The traversal is on the ground(s) that groups I, II, and III are not distinct and are related. Applicant's argument is found persuasive and the restriction requirement is withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 5, 6, 11, 12, 25, 32, and 60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
5. Claims 5, 6, 11, 12, and 25 recite "volatile memory device" and claim 60 recites "volatile memory". This concept is not mentioned in the specification.
6. Claim 32 recites "said custom list is expandable by an electronic transfer within said computer". This concept is not mentioned in the specification.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 2, 17, 32, 43, 44, and 55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors, some examples to follow.
9. Claim 2 recites "said entering". There is insufficient antecedent basis for this limitation in the claim.
10. Claim 17 recites "said standard database is indicative of an ICD9-CM code". It is unclear how a database can be indicative of certain codes.
11. Claim 32 recites "said custom list is expandable by an electronic transfer within said computer". It is unclear how an electronic transfer makes a list expandable.
12. Claims 43 and 44 recite "primary data well suited for being displayed in a text line". The term "well suited" is a relative term which renders the claim indefinite. The term "well suited" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Additionally, it is unclear why there is a need to repeat claim 43 in claim 44.
13. Claim 55 recites "said customizable manner". There is insufficient antecedent basis for this limitation in the claim.

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Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. Claims 1-6, 13-26, 40-50, and 63 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
16. Claims 1-6, 13-26, 40-50, and 63 are directed to a method. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a §101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). None of the critical steps in the body of the method are tied to a particular machine nor execute a transformation, therefore they are non-statutory. For example, the steps of generating, searching, storing, and displaying in claim 1 are not tied to a particular machine in the body of the claim.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
18. Claims 1-41, 43-45, 47-56, and 59-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doerr, et al. (US 2002/0147614 A1) in view of Myers (US 2003/0083903 A1).

19. Claim 1:

Doerr, as shown, discloses the following limitations:

- *generating a hierarchical organization associated with ICD code for the customized list (see at least figures 10-16 and paragraphs 0057-0066);*
- *searching data indicative of the ICD code for at least one item of the ICD code in accordance with at least one received request to add at least one diagnosis to the customized list (see at least figures 10-16 and paragraphs 0057-0066);*
- *storing at least one disease name and at least one code each corresponding to the at least one item of the ICD code within said hierarchical organization into said custom list (see at least figures 10-16 and paragraphs 0057-0066);*

Doerr does not explicitly disclose the following limitation, but Myers as shown does:

- *displaying each stored disease name and corresponding code in an expandable and collapsible tree structure indicative of said hierarchical organization and in a user selectable manner (see at least figure 3U and 3V and paragraph 0124).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

With regard to the limitation of *ICD9-CM* codes, Doerr discloses in at least paragraph 0054 that the codes can be ICD codes. Doerr does not explicitly disclose that the codes are ICD9-CM codes. However, the Examiner takes Official Notice that it is old and well known in the art to use ICD9-CM codes in place of ICD codes because they are based on ICD codes but provide additional morbidity detail. It would have been obvious to modify the combination of Doerr/Myers

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with ICD9-CM codes because it allows simple substitution of one known element for another to obtain predictable results (*KSR International Co. v. Teleflex Inc.*, rationale B).

20. Claim 2:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *repeating said entering and storing to add at least one additional disease name and corresponding code into said custom list* (see at least figures 10-16 and paragraphs 0057-0066).

21. Claim 3:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said hierarchical organization comprises a list name, a category, and a subcategory* (see at least paragraph 0012).

22. Claim 4:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said storing comprises receiving manually entered data* (see at least figure 14 and paragraph 0064).

23. Claim 5:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Myers discloses the limitation of *loading said data indicative of said ICD code into at least one volatile memory device* (see at least paragraph 0037). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at

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substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

With regard to the limitation of *ICD9-CM* codes, Doerr discloses in at least paragraph 0054 that the codes can be ICD codes. Doerr does not explicitly disclose that the codes are ICD9-CM codes. However, the Examiner takes Official Notice that it is old and well known in the art to use ICD9-CM codes in place of ICD codes because they are based on ICD codes but provide additional morbidity detail. It would have been obvious to modify the combination of Doerr/Myers with ICD9-CM codes because it allows simple substitution of one known element for another to obtain predictable results (*KSR International Co. v. Teleflex Inc.*, rationale B).

24. Claim 6:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said custom list* (see at least figures 10-16 and paragraphs 0057-0066).

Furthermore, Myers discloses the limitation of *said storing comprises automatically transferring data from said volatile memory device into said list* (see at least paragraph 0037, i.e. each local processing device has volatile memory, and at least paragraph 0132, i.e. local processing device automatically retrieves, from its own RAM or from remote device, codes from the group of codes, which can include several subgroups). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

Claims 7-12 are directed to the computer readable medium for practicing the method of claims 1-6 above. Therefore, claims 7-12 are rejected for the same reasons as claims 1-6.

25. Claim 13:

Doerr, as shown, discloses the following limitations:

- *generating a hierarchical organization for the customized list, wherein said hierarchical organization is in accordance with a primary hierarchical organization of said standard disease database (see at least figures 10-16 and paragraphs 0057-0066);*
- *searching the standard disease database for at least one item in accordance with at least one received customization instruction, wherein the at least one item is a subset of the standard disease database (see at least figures 10-16 and paragraphs 0057-0066);*
- *entering at least one disease name, and at least one code corresponding thereto from the standard disease database into said hierarchical organization (see at least figures 10-16 and paragraphs 0057-0066),*
- *storing said at least one disease name and said at least one corresponding code within said hierarchical organization into said custom list (see at least figures 10-16 and paragraphs 0057-0066).*

Doerr does not explicitly disclose the following limitation, but Myers as shown does:

- *said at least one disease name and at least one code each correspondent to the at least one item (see at least figures 3U and 3V);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

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26. Claim 14:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *repeating said entering and storing to add at least one additional disease name and corresponding code into said custom list* (see at least figures 10-16 and paragraphs 0057-0066).

27. Claim 15:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said hierarchical organization comprises a list name, a category, and a subcategory* (see at least paragraph 0012).

28. Claim 16:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said standard disease database comprises an international classification of diseases listing* (see at least paragraph 0054).

29. Claim 17:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said standard database is indicative of an ICD code* (see at least paragraph 0054).

With regard to the limitation of *ICD9-CM codes*, Doerr discloses in at least paragraph 0054 that the codes can be ICD codes. Doerr does not explicitly disclose that the codes are ICD9-CM codes. However, the Examiner takes Official Notice that it is old and well known in the art to use ICD9-CM codes in place of ICD codes because they are based on ICD codes but provide additional morbidity detail. It would have been obvious to modify the combination of Doerr/Myers

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with ICD9-CM codes because it allows simple substitution of one known element for another to obtain predictable results (*KSR International Co. v. Teleflex Inc.*, rationale B).

30. Claim 18:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said searching comprises searching the ICD code* (see at least figure 14 and paragraph 0064).

With regard to the limitation of *ICD9-CM codes*, Doerr discloses in at least paragraph 0054 that the codes can be ICD codes. Doerr does not explicitly disclose that the codes are ICD9-CM codes. However, the Examiner takes Official Notice that it is old and well known in the art to use ICD9-CM codes in place of ICD codes because they are based on ICD codes but provide additional morbidity detail. It would have been obvious to modify the combination of Doerr/Myers with ICD9-CM codes because it allows simple substitution of one known element for another to obtain predictable results (*KSR International Co. v. Teleflex Inc.*, rationale B).

31. Claim 19:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said step of entering said disease name and corresponding code comprises manually typing said disease name and corresponding code* (see at least figure 14 and paragraph 0064).

32. Claim 20:

Doerr, as shown, discloses the following limitations:

- *generating a hierarchical organization to contain said custom list* (see at least figures 10-16 and paragraphs 0057-0066);

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- *searching said standard disease database for diseases and corresponding codes using said computer software* (see at least figures 10-16 and paragraphs 0057-0066);
- *receiving user input selecting from said displayed results a disease and corresponding code to add to said custom list* (see at least figures 10-16 and paragraphs 0057-0066);
- *storing data indicative of said disease and corresponding code into said hierarchical organization within said custom list* (see at least figures 10-16 and paragraphs 0057-0066);
- *said storing at least copies said selected disease and corresponding code from said standard disease database to said custom list, and said custom list comprises said hierarchical organization populated with said selected diseases and corresponding codes* (see at least figures 10-16 and paragraphs 0057-0066).

Doerr does not explicitly disclose the following limitation, but Myers as shown does:

- *displaying results from said searching step* (see at least figures 3U and 3V);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

33. Claim 21:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *repeating said searching, displaying, selecting and storing to add additional disease names and corresponding codes into said custom list* (see at least figures 10-16 and paragraphs 0057-0066).

34. Claim 22:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said hierarchical organization comprises a list name, a category, and a subcategory* (see at least figures 10-16 and paragraphs 0057-0066).

35. Claim 23:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said standard disease database comprises an international classification of diseases listing* (see at least paragraph 0054).

36. Claim 24:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said classification corresponds to the ICD code* (see at least paragraph 0054).

With regard to the limitation of *ICD9-CM codes*, Doerr discloses in at least paragraph 0054 that the codes can be ICD codes. Doerr does not explicitly disclose that the codes are ICD9-CM codes. However, the Examiner takes Official Notice that it is old and well known in the art to use ICD9-CM codes in place of ICD codes because they are based on ICD codes but provide additional morbidity detail. It would have been obvious to modify the combination of Doerr/Myers with ICD9-CM codes because it allows simple substitution of one known element for another to obtain predictable results (*KSR International Co. v. Teleflex Inc.*, rationale B).

37. Claim 25:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Myers discloses the limitation of *loading said ICD code into at least one volatile*

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memory device (see at least paragraph 0037). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

With regard to the limitation of *ICD9-CM* codes, Doerr discloses in at least paragraph 0054 that the codes can be ICD codes. Doerr does not explicitly disclose that the codes are ICD9-CM codes. However, the Examiner takes Official Notice that it is old and well known in the art to use ICD9-CM codes in place of ICD codes because they are based on ICD codes but provide additional morbidity detail. It would have been obvious to modify the combination of Doerr/Myers with ICD9-CM codes because it allows simple substitution of one known element for another to obtain predictable results (*KSR International Co. v. Teleflex Inc.*, rationale B).

38. Claim 26:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said custom list* (see at least figures 10-16 and paragraphs 0057-0066).

Furthermore, Myers discloses the limitation of *said selecting and storing, in combination, automatically transfers data of the selected disease and corresponding code to said list* (see at least paragraph 0037, i.e. each local processing device has volatile memory, and at least paragraph 0132, i.e. local processing device automatically retrieves, from its own RAM or from remote device, codes from the group of codes, which can include several subgroups). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it

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helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

39. Claim 27:

Doerr, as shown, discloses the following limitations:

- *at least one computing device (see figure 2);*
- *a code searcher resident on said computer (see at least figure 14);*
- *said code searcher comprises code for, after selection of the at least one upper level, receiving a search request within at least one of the at least two lower levels, and searching at least one of the at least two lower levels of the standard disease database in accordance with the search request and the hierarchy (see at least figures 11-13, i.e. upper level is diagnosis categories and two lower levels are diagnosis subcategories and diagnosis description);*
- *at least one custom list is derived from said standard disease database dependently upon said code searcher (see at least figures 10-16 and paragraphs 0057-0066).*

Doerr does not explicitly disclose the following limitation, but Myers as shown does:

- *displaying each stored disease name and corresponding code in an expandable and collapsible tree structure indicative of said hierarchical organization and in a user selectable manner (see at least figure 3U and 3V and paragraph 0124).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

With regard to the limitation of *suitable for executing a plurality of instructions in the form of code*, this limitation is not positively recited and therefore does not further limit the invention. See MPEP 2106 II C.

40. Claim 28:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said computing device is one selected from the group consisting of a personal computer, a server, a mainframe, and a programmable digital assistant* (see at least figures 1 and 2 and paragraphs 0034-0039).

41. Claim 29:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said code searcher comprises at least one search engine* (see at least figure 14 and paragraphs 0012 and 0064).

42. Claim 30:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. With regard to the limitation of *said search engine utilizes a standard database kernel*, Doerr discloses in at least paragraph 0034-0039 an operating system that includes central server that manages the functions of the system. Doerr does not explicitly disclose that the server utilizes a standard database kernel. However, the Examiner takes Official Notice that it is old and well known in the art to use a database kernel because it is the core of an operating system and helps manage memory, files, and peripheral devices, launches applications, and allocates system resources. It would have been obvious to modify the combination of Doerr/Myers with a standard database kernel because it entails applying a known technique to a known device ready for improvement to yield predictable results (*KSR International Co. v. Teleflex Inc.*, rationale D).

43. Claim 31:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said custom list is organized in accordance with the hierarchy* (see at least figures 10-16 and paragraphs 0057-0066).

44. Claim 32:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said custom list is expandable by an electronic transfer within said computer* (see at least figures 10-16).

45. Claim 33:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said computing instructions enable a user to edit said at least one custom list* (see at least figure 10 and paragraphs 0053-0054).

46. Claim 34:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. With regard to the limitation of *said code searcher comprises code associated with a language selected from the group consisting of C++, REALbasic, JAVA, and XCMD*, Doerr discloses in at least figure 14 and interface to search for codes. Doerr does not explicitly disclose that code searching interface *comprises code associated with a language selected from the group consisting of C++, REALbasic, JAVA, and XCMD*. However, the Examiner takes Official Notice that it is old and well known in the art to use C++, REALbasic, JAVA, and XCMD languages to program a searching interface because these are object oriented languages that are easy to use. It would have been obvious to modify the combination of Doerr/Myers with a *code searcher comprises code associated with a language selected from the group consisting of C++,*

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REALbasic, JAVA, and XCMD because it entails applying a known technique to a known device ready for improvement to yield predictable results (*KSR International Co. v. Teleflex Inc.*, rationale D).

Claims 35-39 are directed to the computer readable medium for practicing the method of claims 20-26 above. Therefore, claims 35-39 are rejected for the same reasons as claims 20-26.

47. Claim 40:

Doerr, as shown, discloses the following limitations:

- *storing data corresponding to the tabular list of the ICD medical diagnosis coding in a first table in a hierarchical manner (see at least figures 10-16 and paragraphs 0057-0066);*
- *providing code for receiving user input for navigating through said tabular list to a desired portion of said data corresponding to said tabular list (see at least figures 10-16 and paragraphs 0057-0066);*
- *providing code for displaying said desired portion of said data corresponding to said tabular list with at least one other portion of said data indicative of said tabular list (see at least figures 10-16 and paragraphs 0057-0066).*

Doerr does not explicitly disclose the following limitation, but Myers as shown does:

- *so as to present said desired portion of said data in an expandable and collapsible tree structure indicative of said hierarchy and in a user selectable manner (see at least figure 3U and 3V and paragraph 0124).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report

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generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

With regard to the limitation of *ICD9-CM* codes, Doerr discloses in at least paragraph 0054 that the codes can be ICD codes. Doerr does not explicitly disclose that the codes are ICD9-CM codes. However, the Examiner takes Official Notice that it is old and well known in the art to use ICD9-CM codes in place of ICD codes because they are based on ICD codes but provide additional morbidity detail. It would have been obvious to modify the combination of Doerr/Myers with ICD9-CM codes because it allows simple substitution of one known element for another to obtain predictable results (*KSR International Co. v. Teleflex Inc.*, rationale B).

48. Claim 41:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Myers discloses the limitation of *each portion of said data corresponding to said tabular list is displayed in an expandable and collapsible tree structure with regard to at least one other related portion of said data corresponding to said tabular list dependently upon said hierarchy* (see at least figure 3U and 3V and paragraph 0124). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

49. Claims 43 and 44:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said other portion comprises primary data well suited for being displayed in a text line* (see at least figures 10-16 and paragraphs 0057-0066).

50. Claim 45:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *storing secondary data corresponding to said desired portion of said primary data in said table* (see at least figures 10-16 and paragraphs 0057-0066).

51. Claim 47:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *providing code for searching said data corresponding to said Tabular List for at least one user entered term* (see at least figure 14 and paragraph 0064).

52. Claim 48:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *providing code for searching said data corresponding to said Alphabetic Index for the at least one user entered term* (see at least figure 14 and paragraph 0064).

53. Claim 49:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *providing code for exporting at least a portion of*

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said stored data in an electronic form (see at least paragraph 0038-0039, data can be transmitted between the handheld device and other remote computers by the internet).

54. Claim 50:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *code for gathering data indicative of said displayed portion of said stored data* (see at least paragraph 0065, i.e. system analyzes historical record of code selection and provides top 20 list of most frequently selected diagnoses).

55. Claim 51:

Doerr, as shown, discloses the following limitations:

- *data corresponding to the tabular list of ICD being stored in at least a first table so as to preserve a hierarchy associated with the ICD* (see at least figures 10-16 and paragraphs 0057-0066);
- *code for receiving user input for navigating through said tabular list to a desired portion of said data corresponding to said tabular list* (see at least figures 10-16 and paragraphs 0057-0066);
- *code for displaying said desired portion of said data corresponding to said tabular list with at least one other portion of said data indicative of said tabular list* (see at least figures 10-16 and paragraphs 0057-0066)

Doerr does not explicitly disclose the following limitation, but Myers as shown does:

- *so as to present said desired portion of said data in an expandable and collapsible tree structure indicative of said hierarchy and in a user selectable manner* (see at least figure 3U and 3V and paragraph 0124).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical

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procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

With regard to the limitation of *ICD9-CM* codes, Doerr discloses in at least paragraph 0054 that the codes can be ICD codes. Doerr does not explicitly disclose that the codes are ICD9-CM codes. However, the Examiner takes Official Notice that it is old and well known in the art to use ICD9-CM codes in place of ICD codes because they are based on ICD codes but provide additional morbidity detail. It would have been obvious to modify the combination of Doerr/Myers with ICD9-CM codes because it allows simple substitution of one known element for another to obtain predictable results (*KSR International Co. v. Teleflex Inc.*, rationale B).

56. Claim 52:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Myers discloses the limitation of *each portion of said data corresponding to said tabular list is displayed in an expandable and collapsible tree structure with regard to at least one other related portion of said data corresponding to said tabular list dependently upon said hierarchy* (see at least figure 3U and 3V and paragraph 0124). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

57. Claim 53:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Myers discloses the limitation of *code for presenting said tabular list of said ICD in a collapsible manner to facilitate said navigating* (see at least figure 3U and 3V and paragraph 0124). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

With regard to the limitation of *ICD9-CM codes*, Doerr discloses in at least paragraph 0054 that the codes can be ICD codes. Doerr does not explicitly disclose that the codes are ICD9-CM codes. However, the Examiner takes Official Notice that it is old and well known in the art to use ICD9-CM codes in place of ICD codes because they are based on ICD codes but provide additional morbidity detail. It would have been obvious to modify the combination of Doerr/Myers with ICD9-CM codes because it allows simple substitution of one known element for another to obtain predictable results (*KSR International Co. v. Teleflex Inc.*, rationale B).

58. Claim 54:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said code for presenting said tabular list comprises code for presenting said tabular list in a user customizable manner* (see at least figures 10-16 and paragraphs 0057-0066).

59. Claim 55:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Myers discloses the limitation of *said customizable manner enables expanding and collapsing views of portions of said tabular list* (see at least figure 3U and 3V and paragraph 0124). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

60. Claim 56:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *code for searching said tabular list* (see at least figure 14 and paragraph 0064).

61. Claim 59:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *code for defining a subset of said tabular list* (see at least figures 10-16 and paragraphs 0057-0066).

62. Claim 60:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Myers discloses the limitation of *loading code for storing in a volatile memory data indicative of said subset* (see at least paragraph 0037). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of

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Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

63. Claim 61:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *code for adding entries to said subset* (see at least figures 10-16 and paragraphs 0057-0066).

Claim 62 is directed to the same limitations as claim 51 above. Therefore, claim 62 is rejected for the same reasons as claim 51.

64. Claim 63:

Doerr, as shown, discloses the following limitations:

- *generating a hierarchical organization associated with ICD code for the customized list* (see at least figures 10-16 and paragraphs 0057-0066);
- *searching data indicative of the ICD code for at least one item of the ICD code in accordance with at least one received request to add at least one diagnosis to the customized list* (see at least figures 10-16 and paragraphs 0057-0066);
- *storing at least one disease name and at least one code each corresponding to the at least one item of the ICD code within said hierarchical organization into said custom list* (see at least figures 10-16 and paragraphs 0057-0066);

Doerr does not explicitly disclose the following limitation, but Myers as shown does:

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- *displaying each stored disease name and corresponding code in an expandable and collapsible tree structure indicative of said hierarchical organization and in a user selectable manner (see at least figure 3U and 3V and paragraph 0124).*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the diagnosis code display method of Myers because it helps in, "...generating an insurance claim form or other billing report and/or a medical procedure report that results in accurate report generation the first time and facilitates report generation by a single operator at substantially the same time as at least a portion of the services are rendered..." (Myers, paragraph 0010).

With regard to the limitation of *ICD-10* codes, Doerr discloses in at least paragraph 0054 that the codes can be ICD codes. Doerr does not explicitly disclose that the codes are ICD-10 codes. However, the Examiner takes Official Notice that it is old and well known in the art to use ICD-10 codes in place of ICD codes because they are more up-to-date codes. It would have been obvious to modify the combination of Doerr/Myers with ICD-10 codes because it allows simple substitution of one known element for another to obtain predictable results (*KSR International Co. v. Teleflex Inc.*, rationale B).

65. Claims 42, 57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doerr, et al. (US 2002/0147614 A1) in view of Myers (US 2003/0083903 A1) in further view of Lavin, et al. (US 5,772,585 A).

66. Claim 42:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *storing data corresponding to an Alphabetic Index of the ICD medical diagnosis coding in a second table with said data corresponding to said*

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Tabular List (see at least figures 10-16, i.e. diagnosis code index is listed in alphabetical order and is corresponding to a tabular list of diagnosis codes).

Doerr does not explicitly disclose the limitation of *cross-referenced tables*. However, in at least column 4, lines 18-32, Lavin discloses a database that stores tables of medical data which cross-reference each other. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the cross-referenced database tables of Lavin because, "...this allows the user to retrieve information in a variety of formats in order to better utilize the information contained in the database..." (Lavin, column 4, lines 28-30).

67. Claim 57:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *code for referencing said tabular list with other data* (see at least figures 10-16 and paragraphs 0057-0066).

Doerr does not explicitly disclose the limitation of *cross-referenced data*. However, in at least column 4, lines 18-32, Lavin discloses a database that stores tables of medical data which cross-reference each other. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the custom diagnosis code list of Doerr with the cross-referenced database tables of Lavin because, "...this allows the user to retrieve information in a variety of formats in order to better utilize the information contained in the database..." (Lavin, column 4, lines 28-30).

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68. Claim 58:

The combination of Doerr/Myers/Lavin discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *said other data comprises the alphabetic index of ICD* (see at least figures 10-16 and paragraphs 0057-0066).

With regard to the limitation of *ICD9-CM* codes, Doerr discloses in at least paragraph 0054 that the codes can be ICD codes. Doerr does not explicitly disclose that the codes are ICD9-CM codes. However, the Examiner takes Official Notice that it is old and well known in the art to use ICD9-CM codes in place of ICD codes because they are based on ICD codes but provide additional morbidity detail. It would have been obvious to modify the combination of Doerr/Myers/Lavin with ICD9-CM codes because it allows simple substitution of one known element for another to obtain predictable results (*KSR International Co. v. Teleflex Inc.*, rationale B).

69. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doerr, et al. (US 2002/0147614 A1) in view of Myers (US 2003/0083903 A1) in further view of Rensimer, et al. (US 6,154,726 A).

70. Claim 46:

The combination of Doerr/Myers discloses the limitations as shown in the rejections above. Furthermore, Doerr discloses the limitation of *providing code for presenting said secondary data responsively to user selection of said presented desired portion of said primary data* (see at least figures 10-16 and paragraphs 0057-0066).

Doerr does not explicitly disclose the limitation of *a pop-up window*. However, in at least column 15, Appendix A, under Case Management Services, Rensimer discloses selecting medical codes from a pop up window. It would have been obvious to one of ordinary skill in the art at the time of

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the invention to combine the custom diagnosis code list of Doerr with the pop-up window of Rensimer because, "...considerable physician and staff time are saved, and the precision and accuracy of patient treatment history are significantly enhanced, by recording these activities contemporaneously with the service rendered..." (Rensimer, column 2, lines 17-20).

Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **JOSEPH BURGESS** whose telephone number is **(571)270-5547**. The Examiner can normally be reached on Monday-Friday, 9:00am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **CHRISTOPHER GILLIGAN** can be reached at **(571)272-6770**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **(866)217-9197** (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
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or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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7/14/2009

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